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Philip J. Lee  
Suite 525  
10050 Regency Circle  
Omaha, NE 68114

EXAMINER

LUGO, CARLOS

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/973,225

Applicant(s)

KAGI, RENE

Examiner

Carlos Lugo

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-5, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 1, 6, 7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 8, 10, 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on March 17, 2003.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 2-5,8,10 and 11 are rejected** under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 2 and 5 recites that the outer rim is smaller than the diameter of the hole. Then, the claims mention that the outer rim has a large enough diameter relative to the diameter of the hole. If the outer rim of the element is smaller than the diameter of the hole, it is unclear how it also can be larger enough relative to the hole.

Claims 2 and 5 recites that the element is place in the hole and by applying an axial force in the direction of the central apex, the rim will expands and engage the wall of the hole. However, the claims also mention that a second axial force is applied in a direction opposed to the first axial force. Then if this second force is applied, the rim will never engage the wall.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. **Claims 10 and 11 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the first surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 2,5 and 8 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 859,733 to Bot.

Regarding claims 2,5 and 8, Bot discloses a device comprising at least one element (4) with a disc shaped surface and a generally uniform thickness. The element has a radially outer rim with a diameter smaller than the diameter of a hole (3). The element has a cone or dome shaped configuration with a central apex raised above the rim in a first direction.

The outer rim has a large enough diameter relative to the diameter of the hole that the rim expands radially outward to engage the wall of the hole upon application of an axial force applied in the first direction. The axial pressure will achieve radial expansion of the element rim and a press fit with a wall of the hole (lines 45-47).

8. **Claims 2,5 and 8 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,058,452 to Hoffmann.

Regarding claims 2,5 and 8, Hoffman discloses a device comprising at least one element (11) with a disc shaped surface and a generally uniform thickness. The element has a radially outer rim with a diameter smaller than the diameter of a hole (9). The element has a cone or dome shaped configuration with a central apex raised above the rim in a first direction.

The outer rim has a large enough diameter relative to the diameter of the hole that the rim expands radially outward to engage the wall of the hole upon application of an axial force applied in the first direction. The axial pressure will achieve radial expansion of the element rim and a press fit with a wall of the hole.

9. **Claims 2-5 and 8 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 4,601,475 to Nicholson.

Regarding claims 2,5 and 8, Nicholson discloses a device comprising at least one element (3) with a disc shaped surface and a generally uniform thickness. The element has a radially outer rim with a diameter smaller than the diameter of a hole (2a). The element has a cone or dome shaped configuration with a central apex raised above the rim in a first direction.

The outer rim has a large enough diameter relative to the diameter of the hole that the rim expands radially outward to engage the wall of the hole upon application of an axial force applied in the first direction. The axial pressure will achieve radial expansion of the element rim and a press fit with a wall of the hole.

As to claim 3, Nicholson discloses two or more similarly shaped elements (3) to be positioned inside a hole (2a) and that when axial pressure is applied, the elements expands.

As to claim 4, Nicholson discloses that the element comprises an outer shoulder to sit on the rim of the hole.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claim 3 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 859,733 to Bot in view of US Pat No 4,601,475 to Nicholson.

Bot fails to disclose that first step is to form two or more similarly shaped elements to be positioned inside the hole. Bot discloses that is form only one element.

Nicholson teaches that is known in the art to form two or more similarly shaped elements (3) to be positioned inside a hole (2) and that when axial pressure is applied, the elements expands.

Applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two or more similarly shaped elements, as taught by Nicholson, into a device as described by Bot, because it is consider as a duplication of a component that will not affect the sealing engagement.

**12. Claim 3 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,058,452 to Hoffman in view of US Pat No 4,601,475 to Nicholson.

Hoffmann fails to disclose that first step is to form two or more similarly shaped elements to be positioned inside the hole. Hoffman discloses that is form only one element.

Nicholson teaches that is known in the art to form two or more similarly shaped elements (3) to be positioned inside a hole (2) and that when axial pressure is applied, the elements expands.

Applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two or more similarly shaped elements, as taught by Nicholson, into a device as described by Hoffmann, because it is consider as a duplication of a component that will not affect the sealing engagement.

**13. Claims 10 and 11 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 859,733 to Bot in view of US Pat No 3,326,560 to Trbovich.

Bot fails to disclose that the element has a second frustoconical surface inverted with respect to the first surface and an annulus of elastomer inserted between the two surfaces.

Trbovich teaches that is known in the art to have two inverted connected frustoconical surfaces (4) with an elastomer (2) between them.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a similar element structure, as taught by Trbovich, into a device as described by Bot, in order to seal the walls of the hole.

#### ***Response to Arguments***

14. Applicant's arguments filed on March 17, 2003 have been fully considered but they are not persuasive.

Regarding applicant's arguments that Bot fails to disclose that when the axial pressure is applied, the element will be flattened (Page 5 Line 1), Bot discloses the invention. The element is place in the hole and then axial pressure, exerted by the clamping means, will flat the element.

As to applicant's arguments that Hoffman fails to disclose the invention claimed (Page 5 Line 29), Hoffman discloses the invention as claimed.

#### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo. The examiner phone number is (703)-305-9747. The fax number for correspondence before a final action is (703)-872-9326 and the fax number for correspondence after final action is (703)-872-9327. The email direction of the examiner is carlos.lugo@uspto.gov. The examiner can normally be reached on Monday to Friday from 9:30am to 6:30pm (EST). If the examiner is not available, please leave a message, including the application number and the examiner will answer the message as soon as possible.

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April 17, 2003

  
ROBERT J. SANDY  
PRIMARY EXAMINER